

REMARKS

Applicants have carefully studied the Election/Restriction Requirement, which issued in connection with the above-identified application. The present response is intended to be fully responsive to all points raised by the Examiner. An early action on the merits is respectfully requested.

In the Office Action, the Examiner has required restriction to one of the following groups of claims under 35 U.S.C. §§ 121 and 372:

Group I: claims 1, 2, 7-10, 12, 13, 15, 16, 25, 39, 40, 42-50, 85, 86, and 88 drawn to methods for evaluating, diagnosing, determining the prognosis of, and determining the susceptibility to a physical state, disease, or disorder of a subject using expression profiles or altered expression.

Group II: claims 55 and 56, drawn to a method for predicting a response to or to a method of choice of treatment or therapy in a subject comprising comparing expression profiles of another subject.

Group III: claims 64, 65, 78 and 79, drawn to methods for identifying a nucleic acid containing a sequence alteration that results in and/or contributes to a disease or disorder comprising selecting a nucleic acid that has altered expression.

Group IV: claims 90 and 104, drawn to methods for developing therapeutic compounds for a disease or disorder resulting from and/or contributed to by an altered expression of a nucleic acid.

Group V: claims 93 and 97, drawn to methods for treating a subject with a disease or disorder resulting from and/or contributed to by an altered expression of a nucleic acid comprising administering effective amounts of a nucleic acid which is a normal counterpart of the nucleic acid or an inhibitory nucleic acid specific for the nucleic acid.

The Examiner states that the above invention groups lack unity of invention, because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In order to be fully responsive to the Election/Restriction Requirement, applicants hereby elect, with traverse, to prosecute the claims of Group I (claims 1, 2, 7-10, 12, 13, 15, 16, 25, 39, 40, 42-50, 85, 86, and 88).

Applicants respectfully traverse the Election/Restriction Requirement and reserve the right to petition therefrom under 37 C.F.R. §1.144. In particular, applicants respectfully request reconsideration and modification of the Election/Restriction Requirement to allow examination of all groups of claims in the same application, for the reasons provided as follows.

According to USPTO examining procedures, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803).

Applicants respectfully note that all pending claims involve obtaining and analyzing/comparing expression profile of surrogate cells from a subject. It follows, that a proper search for each of the claimed methods would involve a search of a method for obtaining and analyzing/comparing expression profile of surrogate cells from a subject. The similarity of the patentability issues between the claims of Groups I-V is further emphasized by the fact that claims 97 (Group V) and 104 (Group IV) refer back to claim 2 (Group I); and claims 85-86 and 88 (Group I), 90 (Group IV) and 93 (Group V) refer back to claim 64 (Group III). Thus, the search for any group of these claims would necessarily be co-extensive with the search for other groups and examination of these groups together would not be an undue burden on the Examiner.

In light of the foregoing practice and arguments, it can be concluded that the claims of provisionally elected Group I contain multiple unifying features with the claims of all other groups. The claims of these groups represent a web of knowledge and continuity of effort that merits examination in a single application. The search and examination of each group is necessarily co-extensive, and in any event would involve such interrelated art that the search and examination of all groups can be made without undue burden on the Examiner. Accordingly, applicants respectfully request that the Examiner withdraws the Election/Restriction Requirement to allow prosecution of Groups I-V together in the same application.

CONCLUSION

Applicants request entry of the foregoing election and remarks in the file history of this application. In view of the above arguments, withdrawal of the Election/Restriction Requirement is respectfully requested, and an early action on the merits is courteously solicited.

If the Examiner believes that a telephone conversation would help advance the prosecution in this case, the Examiner is respectfully requested to call the undersigned attorney at (212) 527-7634. The Examiner is hereby authorized to charge any additional fees associated with this response to our Deposit Account No. 04-0100.

Dated: September 16, 2009

Respectfully submitted,

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